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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,501	11/28/2000	Dave McDysan	RIC00043	7593
25537	7590	08/18/2009		
VERIZON PATENT MANAGEMENT GROUP 1320 North Court House Road 9th Floor ARLINGTON, VA 22201-2909			EXAMINER GOLD, AVIM	
			ART UNIT 2457	PAPER NUMBER
			NOTIFICATION DATE 08/18/2009	DELIVERY MODE ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE MCDYSAN, HOWARD LEE THOMAS, and LEI YAO

Appeal 2009-000286
Application 09/723,501
Technology Center 2100

Decided: August 14, 2009

Before JOSEPH L. DIXON, JAY P. LUCAS, and THU A. DANG,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal the Examiner's final rejection of claims 2-18 and 20-38 under 35 U.S.C. § 134 (2002). Claims 1 and 19 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b)(2002).

We reverse.

I. STATEMENT OF THE CASE

A. INVENTION

According to Appellants, the invention relates to communication networks, and in particular, to an IP-centric communication network (Spec. 1, ll. 25-26).

B. ILLUSTRATIVE CLAIM

Claim 37 is exemplary and is reproduced below:

37. An external processor for a network access system having a programmable access device, comprising:

- a message processor configured to parse a message for determining a type of communication service;

- a service controller configured to receive the message if the type of communication service corresponds to the service controller, wherein the service controller determines a policy based on the message and generates a control signal according to the policy; and

- a programmable access device (PAD) controller configured to receive the control signal for configuring a PAD to enforce the policy with respect to a network connection between a first network and a second network.

C. REJECTIONS

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Gai	US 6,167,445	Dec. 26, 2000
Bowman-Amuah	US 6,442,547	Aug. 27, 2002
Bullock	US 6,631,414	Oct. 7, 2003
Miles	US 6,665,495	Dec. 16, 2003

(filed on Oct. 27,2000)

Claims 2-6, 9, 20-24, 27, 37, and 38 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the teachings Miles.

Claims 7, 8, 10, 11, 25, 26, 28, and 29 stand rejected under 35 U.S.C. § 103(a) over the teachings Miles in view of Gai.

Claims 12, 13, 30, and 31 stand rejected under 35 U.S.C. § 103(a) over the teachings Miles in view of Bullock.

Claims 14-18 and 32-36 stand rejected under 35 U.S.C. § 103(a) over the teachings Miles in view of Bowman-Amuah.

II. ISSUE

Have Appellants shown that the Examiner erred in finding that the Declaration under 37 C.F.R. § 1.131 is ineffective to overcome the primary reference to Miles?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1. Appellants' application was filed on November 28, 2000 (Exh. M).
2. The primary reference to Miles was filed on October 27, 2000 (Miles).
3. Appellants submitted a properly signed Declaration under 37 C.F.R. § 1.131 on April 13, 2006, and the Declaration has been entered (Final Rej.).
4. Appellants' Declaration states that "[w]e conceived our invention in this country long prior to October 27, 2000" and that "[I]ong prior to October 27, 2000, we prepared a description of our invention, a copy which is attached" (Decl. 2).
5. The Invention Disclosure Form was signed by Appellants on April 27, 2000, May 1, 2000, and May 2, 2000 (Exh. A).
6. Appellants' Declaration states that "[p]rior to October 27, 2000, and through November 28, 2000, we collaborated with Attorneys... in their preparations of drafts of the above-referenced patent application" (Decl. 2), wherein Exhibits attached denote email messages from Appellants to Attorneys from August 31, 2000 to November 22, 2000 during the collaboration (Exh. B-L).

IV. PRINCIPLES OF LAW

Declaration under 37 C.F.R § 1.131

§ 1.131 Affidavit or declaration of prior invention:

(a) When any claim of an application . . . is rejected, the inventor of the subject matter of the rejected claim . . . may submit an appropriate . . . declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. . . .

(b) The showing of facts shall be such, in character and weight, as to establish [1] reduction to practice prior to the effective date of the reference, or [2] conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent [actual] reduction to practice or to the filing of the application [i.e., a constructive reduction to practice]. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the . . . declaration or their absence must be satisfactorily explained.

A declaration submitted pursuant to Rule 131 is evaluated on its merits by considering the evidence relied upon in light of the arguments made explaining why the evidence is sufficient. The Board has broad discretion as to the weight to be given the evidence. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004); *In re Inland Steel, Co.*, 265 F.3d 1354, 1366 (Fed. Cir. 2001).

V. ANALYSIS

In response to the Examiner's rejections of the claims over Miles alone and Miles in view of Gai, Bullock or Bowman-Amuah, Appellants contend that Appellants' Declaration submitted pursuant to 37 C.F.R. § 1.131 "is effective to remove Miles et al. as a reference" (App. Br. 9). In particular, Appellants contend that "the Invention was conceived in this

Country prior to October 27, 2000” and that “the description was prepared prior to October 27, 2000” (App. Br. 7). Thus, Appellants contend that “conception has been established prior to October 27, 2000,” the filing date of Miles (*Id.*).

The Examiner maintains the rejection of the claims over Miles alone and Miles in view of Gai, Bullock or Bowman-Amuah and finds that the Declaration “does not satisfy the requirements of 37 CFR 1.131(b)” (Ans. 13). In particular, the Examiner finds that “Appellant has done nothing other than point to over 90 pages as proof of conception without any explanation of what facts are established in the exhibits and used in the claims” (Ans. 14).

Accordingly, the threshold issue is whether Miles is antedated by Appellants' Declaration under 37 C.F.R. § 1.131.

Miles was filed 32 days prior to the filing of Appellants' application (FF 1-2). However, Appellants declare that Appellants' invention was conceived before Miles' filing date (FF 3-4). Appellants submitted a disclosure document describing Appellants' invention, wherein the last signature on the disclosure document is prior to Miles' filing date (FF 5). Appellants also submit communications between Appellants and Attorneys between the submission of the disclosure document (but prior to Miles' filing date) and the filing date of Appellants' application, setting forth collaboration to file the disclosure document as the subject application (FF 6).

We find the conception of Appellants' invention to be prior to Miles' filing date as evidenced by the disclosure document. In particular, we find that there is sufficient evidence showing that the disclosure document is submitted prior to Miles' filing date and that the disclosure document is a description of Appellants' invention as set forth in the subject application. That is, we find that the invention set forth in the disclosure document is conceived at the latest in May 2000, the last signing date of the disclosure document, before Miles' filing date of October 2000, and certainly before Appellants' filing date of just 32 days after Miles' filing date. In particular, we find that the disclosure document and emails between August and November 2000 showing collaboration between Appellants and Attorneys to file the disclosure document as the subject application are sufficient evidence showing conception of the invention in the subject application before Miles' filing date.

Accordingly, we conclude that Miles is antedated by Appellants' Declaration under 37 C.F.R. § 1.131. Appellants have therefore shown that the Examiner erred in holding that the declaration under 37 C.F.R. § 1.131 is ineffective to overcome Miles. Therefore, Miles is disqualified as prior art in each of the applied rejections, and we cannot sustain the rejections.

CONCLUSIONS

(1) Appellants have shown that the Examiner erred in finding that claims 2-6, 9, 20-24, 27, 37, and 38 are anticipated by the teachings of Miles.

(2) Appellants have shown that the Examiner erred in finding that claims 7, 8, 10, 11, 25, 26, 28, and 29 are unpatentable over the teachings Miles in view of Gai.

(3) Appellants have shown that the Examiner erred in finding that claims 12, 13, 30, and 31 are unpatentable over the teachings Miles in view of Bullock.

(4) Appellants have shown that the Examiner erred in finding that claims 14-18 and 32-36 are unpatentable over the teachings Miles in view of Bowman-Amuah.

DECISION

We reverse the Examiner's decision rejecting claims 2-6, 9, 20-24, 27, 37 and 38 under 35 U.S.C. § 102(a), and claims 7, 8, 10-18, 25, 26, and 28-36 under 35 U.S.C. § 103(a).

REVERSED

PEB

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